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EXAMINER

GAMBETTA, KELLY M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN DAVID SANDERSON

Appeal 2009-003550
Application 09/744,420
Technology Center 1700

Decided: February 25, 2010

Before BRADLEY R. GARRIS, TERRY J. OWENS, and
MARK NAGUMO, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

ORDER REMANDING TO EXAMINER

We remand this application to the jurisdiction of the Examiner for action consistent with our comments below.

Appellant has appealed from the Examiner's Office Action, mailed August 16, 2007, wherein all pending claims 1-4, 6-22, and 34-44 were rejected under 35 U.S.C. § 103. The Examiner's decision rejecting these claims involved 6 distinct rejections. The references applied in two of these

rejections included US patent 5,324,537 to Proscia et al (Office Action 11-14). Significantly, the references applied in two other rejections included US patent 5,286,520 to Proscia (*id.* at 14-18). The rejections in this Office Action correspond to those set forth in the Answer including the distinct rejections based on Proscia et al ‘537 (Ans. 9-12) and Proscia ‘520 (*id.* at 12-16) respectively.

In the Brief, filed June 16, 2008, Appellant incorrectly listed for review on appeal the rejections set forth in the August 16, 2007 Office Action. Specifically, the rejections labeled as E) and F) were incorrectly listed as based on Proscia et al ‘537 instead of Proscia ‘520 (Br. 12-13). Significantly, the Examiner’s Answer failed to point out this error (Ans. 3 at “Grounds of Rejection to be Reviewed on Appeal”). Moreover, the Answer obscured this error by failing to include Proscia ‘520 in the list of applied references (*id.* at “Evidence Relied Upon”).

Appellant’s above noted error was carried into the “Argument” section of the Brief wherein arguments presented for the rejections labeled as E) and F) were incorrectly based on Proscia et al ‘537 instead of the applied reference to Proscia ‘520 (Brief 31-35). Again, the Examiner’s Answer failed to identify this error in Appellant’s arguments (Ans. 22).

As a consequence of Appellant’s apparently inadvertent errors and the Examiner’s failure to identify them, the record of this Appeal contains no arguments by Appellant against the Examiner’s outstanding § 103 rejections of all appealed claims based on the Proscia ‘520 reference. This circumstance warrants a determination that the Appellant’s Appeal Brief fails to comply with the content requirements set forth in 37 C.F.R. § 41.37(c)(vi) and (vii).

Therefore, in response to this Remand, the Examiner must issue to the Appellant a Notice of Non-Compliant Appeal Brief as set forth in the Manual of Patent Examining Procedure (MPEP) § 1205.03(Rev. 3, August 2005). Assuming Appellant responds to this notice by filing a compliant amended brief, the Examiner must respond to this amended brief with a new Examiner's Answer which properly lists, as "Evidence Relied Upon", each of the prior art references applied in the rejections on appeal including Proscia '520. The new Examiner's Answer also must respond to arguments in the amended brief concerning Proscia '520.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01(D) (Rev. 6, Sept. 2007). It is important that the Board be promptly informed of any action affecting the appeal in this case.

For the reasons set forth above, this application is remanded to the jurisdiction of the Examiner.

REMAND

tc

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